

NOV 22 2004

FAX TRANSMISSION**DATE:** November 22, 2004**PTO IDENTIFIER:** Application Number 10/649,951-Conf. #6259
Patent Number**Inventor:** Dana V. Ferraris et al.**MESSAGE TO:** US Patent and Trademark Office**FAX NUMBER:** (703) 872-9306**FROM:** CONNOLLY BOVE LODGE & HUTZ LLP

Mark J. Pino

PHONE: (202) 331-7111**Attorney Dkt. #:** 22227-00003-US2**PAGES (Including Cover Sheet):** 6**CONTENTS:**Certificate of Transmission (1 page); and
Response to Election of Species Requirement (4 pages).

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Application No. (if known): 10/649,951

Attorney Docket No.: 22227-00003-US2

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Response to Election of Species Requirement (4 pages).

NOV 22 2004

Application No.: 10/649,951

Docket No.: 22227-00003-US2
(PATENT)**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

In re Patent Application of:

Dana V. Ferraris et al.

Application No.: 10/649,951

Confirmation No.: 6259

Filed: August 28, 2003

Art Unit: 1625

For: SYMMETRICALLY DISUBSTITUTED
AROMATIC COMPOUNDS AND
PHARMACEUTICAL COMPOSITIONS FOR
INHIBITING POLY (ADP-RIBOSE)
GLYCOHYDROLASE, AND METHODS FOR
THEIR USE

Examiner: H. M. Reyes

RESPONSE TO RESTRICTION REQUIREMENT

Customer Window, MS Amendment
U.S. Patent and Trademark Office
220 20th Street S.
Crystal Plaza Two, Lobby, Room 1B03
Arlington, Virginia 22202

Dear Sir:

In response to the restriction requirement set forth in the Office Action mailed October 21, 2004, Applicants hereby traverse and provisionally elect claims 47-60 for continued examination.

REMARKS

The Examiner has restricted claims 47-60 into the following four groups (summarized):
(I) nonheterocyclic derivatives of Formula IV; (II) heterocyclic derivatives of Formula IV; (III)

1 of 4

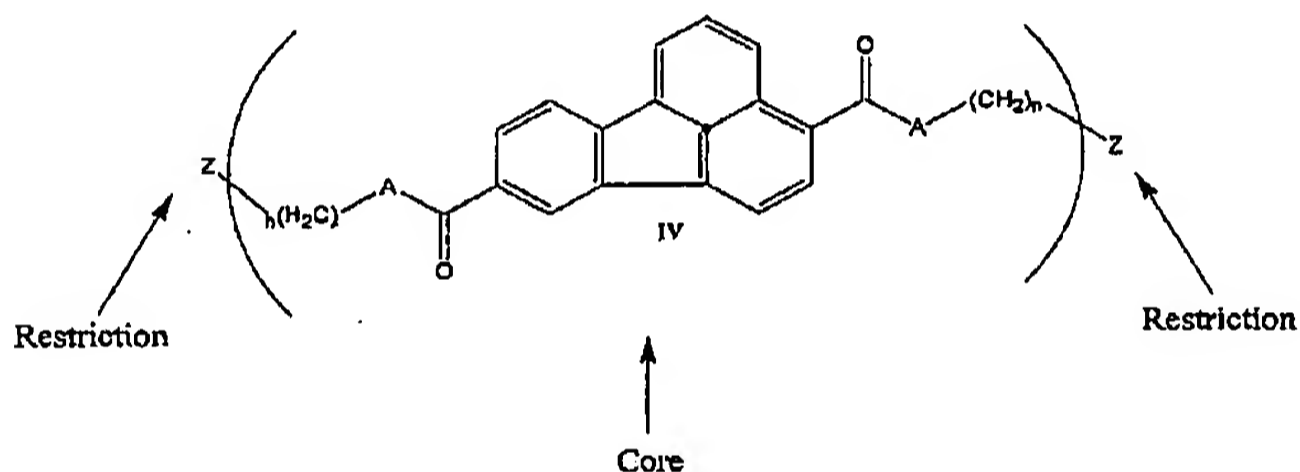
Application No.: 10/649,951

Docket No.: 22227-00003-US2
(PATENT)

methods of using nonheterocyclic derivatives of Formula IV; and (IV) methods of using heterocyclic derivatives of Formula IV. See Restriction, pg. 2.

The groupings are justified as being distinct and unrelated because "they have different modes of operation, different functions, or different effects." Restriction, pg. 3. "In the instant case Invention I and II are unrelated because they are different inventions since each one of the said groups are drawn to compounds having a particular core per groups" Restriction, pgs. 3-4.

Applicants disagree with the Examiner's description of the invention. As seen in the below Formula IV,



while each of the four groups has a particular core, it is the exact same Formula IV core in each group. The variability the Examiner apparently restricts (heterocyclic vs. nonheterocyclic) occurs at the core's outer edges, i.e., the Z substituent. Given the exactness of the core moieties, the applicants disagree the restrictions to the Z substituent render claims 47-60 unrelated for search purposes.

Moreover, each of the Formula IV compounds present in claims 47-60 are disclosed as PARG inhibitors. See Table 1, pg. 68 of the application. In other words, they function as and have the effect of PARG inhibitors. The Examiner has not pointed to anywhere in the specification where the claimed compounds "have different modes of operation, different functions, or different effects" as required under MPEP 808.01. Indeed, Comment 1 to MPEP

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(PATENT)**

808.01 states "The form paragraph is to be used only when claims are presented to unrelated inventions, e.g., a necktie and a locomotive bearing." Applicants submit that the claimed PARG inhibitors of Formula IV are simply not independent inventions as contemplated under MPEP 808.01.

The Examiner argues that Inventions I and II are unrelated because "a reference anticipating or suggesting a given group cannot be used to reject any of the others under the meaning of 35 USC 102 or 35 USC 103." Restriction, pg. 4. This argument concerning a hypothetical piece of prior art that may or may not render one group unpatentable is irrelevant. "For the purpose of a decision on the question of restriction . . . the claims are ordinarily assume to be in proper form and patentable (novel and unobvious) over the prior art." MPEP 806.02: Patentability Over the Prior Art Not Considered.

Applicants also note that in the parent case, U.S. Application No. 09/829,827, now Patent no. 6,635,786, elected claims 93-104 to Formula VII compounds were one of eight restricted groups. Like pending claims 47-60, claims 93-104 to Formula VII compounds had an identical core moiety. And the Formula VII core moiety, similar to the Formula IV core moiety at issue, was substituted at its outer edges by a substituent ("Q") that was either a heterocyclic or nonheterocyclic variant. Unlike in the present application, however, claims 93-104 to Formula VII compounds were not further restricted in any way. Applicants believe that the precedent set by the lack of a restriction in the parent case to claims 93-104 should be followed resulting in no further restriction of claims 47-60.

For the above reasons the Examiner's four way restriction of claims 47-60 should be vacated in its entirety. Alternatively, Applicants select Group II directed to claims 47-57 and choose the species shown in claim 49 for search purposes.

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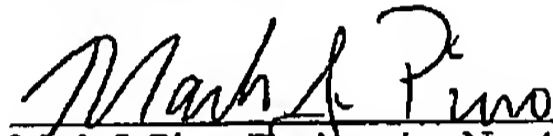
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(PATENT)**

Applicants believe no fee is due with this response. However, if a fee is due, please charge our Deposit Account No. 22-0185, under Order No. 22227-00003-US2 from which the undersigned is authorized to draw.

Dated: November 22, 2004

Respectfully submitted,

By:


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